

03 JUN 2003



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In re Application of : DECISION ON
Allamanche et al :
PCT No.: PCT/EP99/09978 : PETITION UNDER
Application No: 09/914,371 :
Int. Filing Date: 15 December 1999 :
Priority Date: 24 February 1999 : 37 CFR 1.47(a)
Attorney's Docket No.: SCHO0064 :
For: Device and Method for Producing :
An Encoded Audio and/or Video data Stream :
:

This is in response to the "PETITION BASED UPON UNAVAILABILITY OF INVENTOR (37 CFR.1.47/MPEP 409.03)" filed on 14 December 2001. The requisite \$130 petition fee has been charged to petitioner's deposit account.

BACKGROUND

On 15 December 1999, applicants filed international application PCT/EP99/09978, which claimed priority of an earlier European application filed 24 February 1999. A DEMAND was filed on 22 September 2000 prior to the expiration of 19 months from the priority date electing the United States. Accordingly, the thirty-month (30) time period for paying the basic national fee in the United States of America expired at midnight on 24 August 2001.

On 24 August 2001, applicants filed for entry into the national stage in the United States of America. Filed with the application was, inter alia, the requisite basic national fee. No executed oath or declaration from the inventors accompanied the application at such time. A copy of the intentional application was transmitted on 31 August 2000 to the USPTO from the International Bureau.

On 19 August 2001, the United States Designated/Elected Office (DO/EO/US) mailed a "NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 IN THE UNITED STATES DESIGNATED/ELECTED OFFICE (DO/EO/US)" (Form PCT/DO/EO/905) which informed applicant, inter alia, that an "Oath or Declaration of the inventors, in compliance with 37 CFR 1.497(a), and (b), identifying the application by International application number and international filing date" must be submitted within two months from its 19 August 2001 date of mailing or by 32 months from the priority date, whichever is later, in order to avoid abandonment of the national stage application.

On 14 December 2001, petitioner filed the present petition accompanied, inter alia, an executed Declaration without the signature of one of the four inventors, i.e., without the signature of Niels Rump.

DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by (1) the fee under 37 CFR 1.17(h), (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the missing inventor, and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and on behalf of the non-signing joint inventor.

Furthermore, section 409.03(d) of the Manual of Patent Examining Procedure (M.P.E.P.) **Proof of Unavailability or Refusal**, the relevant sections states, in part:

INVENTOR CANNOT BE REACHED:

Where inability to find or reach a nonsigning inventor "after diligent effort" is the reason for filing under **37 CFR 1.47**, a statement of facts should be submitted that fully describes the exact facts which are relied on to establish that a diligent effort was made.

The fact that a nonsigning inventor is on vacation or out of town and is therefore temporarily unavailable to sign the declaration is not an acceptable reason for filing under **37 CFR 1.47**.

Furthermore, the fact that an inventor is hospitalized and/or is not conscious is not an acceptable reason for filing under **37 CFR 1.47**. **37 CFR 1.43** may be available under these circumstances. See **MPEP § 409.02**. Such a petition under **37 CFR 1.47** will be dismissed as inappropriate.

The statement of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted. Copies of documentary evidence such as internet searches, certified mail return receipts, cover letters of instructions, telegrams, that support a finding that the nonsigning inventor could not be found or reached should be made part of the statement. The steps taken to locate the whereabouts of the nonsigning inventor should be included statement of facts. It is important that the statement contain facts as opposed to conclusions.

Petitioner has satisfied requirements (1), (3), and (4) of 37 CFR 1.47(a). However, requirement (2) has not been satisfied.

The averments of Fritz Schoppe are insufficient to support a finding that the nonsigning inventor, Mr. Niels Rump could not be found after diligent effort because Mr. Schoppe's declaration fails to show diligent effort to locate inventor Rump. Mr. Schoppe has not shown that he has searched for the above non-signing inventor's new address by using a broad search in the internet, which would show diligent effort by Mr. Schoppe to find the nonsigning inventor since Mr. Schoppe currently appears to have limited his search to Erlangen.

Moreover, it is not clear from the petition that it was Mr. Schoppe who performed the items listed in paragraph 2 of his declaration, and has first hand knowledge of those facts as required by MPEP Section 409.03(d). If Mr. Schoppe was not the person who performed the actions listed in paragraph 2, petitioner will need to submit statements, with specific facts on the actions referred to by paragraph 2 by persons who have first-hand knowledge of such facts.

In addition although, petitioner has submitted copies of the cover letters and returned envelopes mailed to Mr. Rump, petitioner has not provided English translations of them.

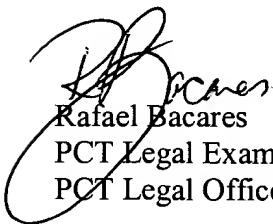
Consequently, at this time it can not be concluded that the nonsigning Mr. Rump could not be found after diligent effort.

CONCLUSION

The petition under 37 CFR 1.47(a) is **DISMISSED** without prejudice.

If reconsideration of the merits of the petition under 37 CFR 1.47(a) is desired, applicant must file a request for reconsideration within **TWO (2) MONTHS** from the mail date of this Decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)." Extensions of time are available under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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